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**Birch, Stewart, Kolasch & Birch, LLP**

# Fax

**To:** Board of Patent Appeals and  
Interferences

**From:** Elliot Goldberg

BPAI Hearings

**Fax:** 703-308-6199

**Date:** February 11, 2003

**Phone:**

**Pages:** 10 (including cover sheet)

**Your Ref.:** 08/841,318

**Our Ref.:** 1259-0181P

**Re:**

**CC:**

☒ **Urgent**    ☐ **For Review**    ☐ **Please Comment**    ☐ **Please Reply**    ☐ **Please Recycle**

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**Comments:** Hearing scheduled for Thursday, February 20, 2003 at  
1:00 pm.

PATENT  
1259-0191P

## IN THE U.S. PATENT AND TRADEMARK OFFICE

In re application of Before the Board of Appeals

Kouki HATAKEYAMA

Appeal No.: 2002-0610

Application No.: 08/841,318

Group: 2612

Filed: April 30, 1997

Examiner: A. Harrington

For:

A METHOD OF CONTROLLING THE DISPLAY  
MODE AND THE RECORDING MODE OF AN  
ELECTRONIC STILL CAMERA (As Amended)CITATION OF NEW AUTHORITY UNDER THE PROVISIONS OF 1.192(a)Assistant Commissioner for Patents  
Washington, DC 20231  
Sir:

February 11, 2003

DISCUSSION

In the rejection of claim 7 on page 8 of the Examiner's Answer, it was stated as follows:

Although not specifically disclosed by Iura, it would have been matter of common sense, that a storage time calculated/determined . . . (Emphasis added).

In the case of *In re Zurko*, 59 USPQ 2<sup>nd</sup>, 1693, 1697 (Fed. Cir. 01), the Court stated as follows:

This assessment of basic knowledge and common sense was not based on any evidence in the record, and, therefore lacked substantial evidence support. (Emphasis added).

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Therefore, *In re Zurko*, (cited above), is further evidence that the rejection based on "common sense" is not valid.

In presenting the above authority, this is in addition to the traverse of the rejection of claim 7, which is of record and is maintained.

**REASON FOR PRESENTING AUTHORITY**

The *In re Zurko* case was not argued in the Brief or the Reply Brief, because the case was decided on August 2, 2001, which was after the Reply Brief filed on May 29, 2001.

It is therefore submitted that the *In re Zurko* case should be considered, because it was not available until after the Reply Brief was filed. It is submitted that this explanation meets the requirement of "good cause", as set forth in 37 C.F.R. 1.92(a), last sentence.

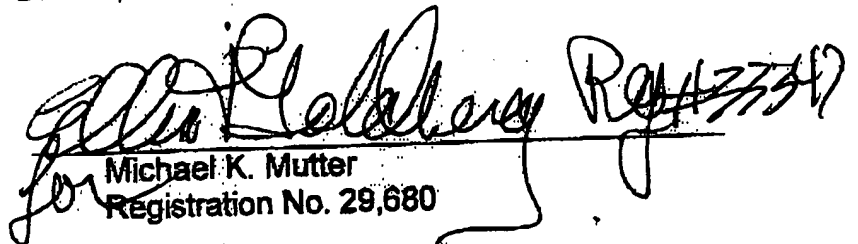
Application No. 08/841,318

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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By

   
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1259-0191P